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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,913	12/10/2003	David A. Fell	659/1715 KC 19441	6819
757	7590	10/18/2006	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			BOGART, MICHAEL G	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/732,913

Applicant(s)

FELL ET AL.

Examiner

Michael G. Bogart

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 25-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections – 35 USC § 102/103*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

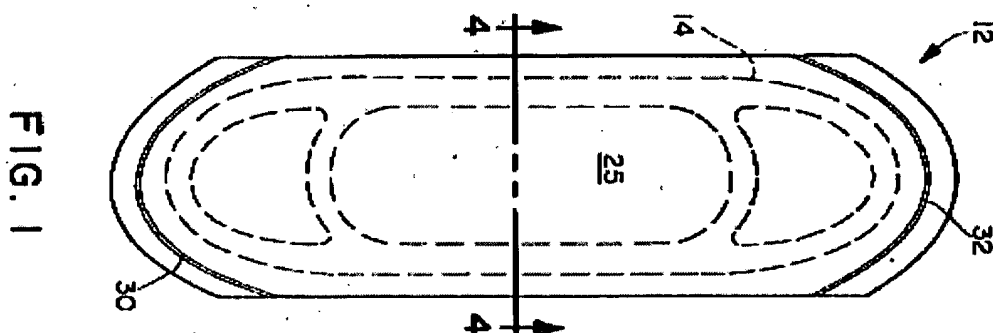
Art Unit: 3761

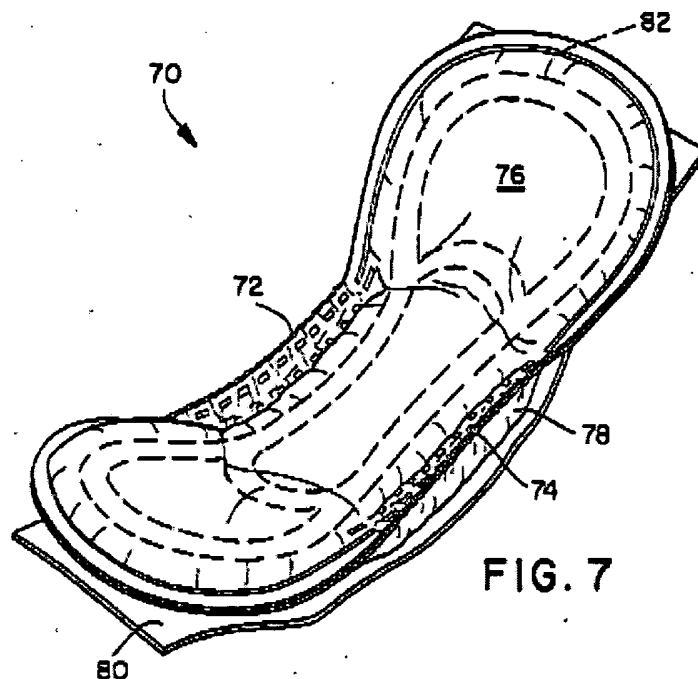
Claims 10-13 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Mason, Jr. *et al.* (US 4,886,513; hereinafter "Mason").

Regarding claims 10-12, Mason teaches an absorbent article (12) that resists permanent creasing comprising:

an absorbent core (20) comprising an activation layer (14) and at least first and second opposite longitudinal end portions each defining a body side surface, wherein said absorbent article (12) is independently movable from a folded condition, wherein said body side surfaces of said first and second portions face will each other in a substantially parallel relationship under a sufficient applied pressure applied to said first and second portions, to an unfolded condition, wherein no pressure is applied to said first and second portions;

wherein said body-side surfaces of said first and second portions form at least one angle greater than or equal to about 90° to 130° in said unfolded condition (abstract)(see figures 1 and 7, *infra*).





Mason is silent as to the article performance vectors which are functional limitations.

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function.

See *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

MPEP § 2114.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. §§ 102 and 103, expressed as a 102/103 rejection. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. § 103 and for anticipation under 35 U.S.C. § 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function,

Art Unit: 3761

property or characteristic. Therefore, a 35 U.S.C. § 102/103 rejection is appropriate for these types of claims as well as for composition claims.

“[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency under 35 U.S.C. § 102, on prima facie obviousness’ under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, supra). MPEP § 2112.

The device of Mason teaches an activating layer (14) made from materials which are springy and enable the article to return to its shape after deformation, see page 2, lines 1-15. Because of the springy construction of Mason, it is the interpretation of this Office that it will perform in the same or similar manner as the device claimed in the instant invention.

Regarding the rejection for obviousness under 35 USC § 103, Mason teaches an absorbent article designed to stay relatively flat once removed from its packaging for use and to resist deformation. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have the article unfold to the relatively flat position rapidly after removing it from the packaging for use by a wearer.

Regarding claim 13, Mason teaches a third longitudinally central crotch portion located between the longitudinal end portions.

Claims 10-13 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Rainville-Lonn *et al.* (US 2003/0114805 A1; hereinafter "Rainville-Lonn").

Regarding claims 10-12, Rainville-Lonn teaches an absorbent article (10) that resists permanent creasing comprising:

an absorbent core comprising an activation layer (14) and at least first and second opposite longitudinal end portions each defining a body side surface, wherein said absorbent article (10) is independently movable from a folded condition, wherein said body side surfaces of said first and second portions face will each other in a substantially parallel relationship under a sufficient applied pressure applied to said first and second portions, to an unfolded condition, wherein no pressure is applied to said first and second portions;

wherein said body-side surfaces of said first and second portions form at least one angle greater than or equal to about 90° to 130° in said unfolded condition (abstract)(see figures 1 and 2, *infra*).

Rainville-Lonn is silent as to the article performance vectors which are functional limitations. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). MPEP § 2114.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. §§

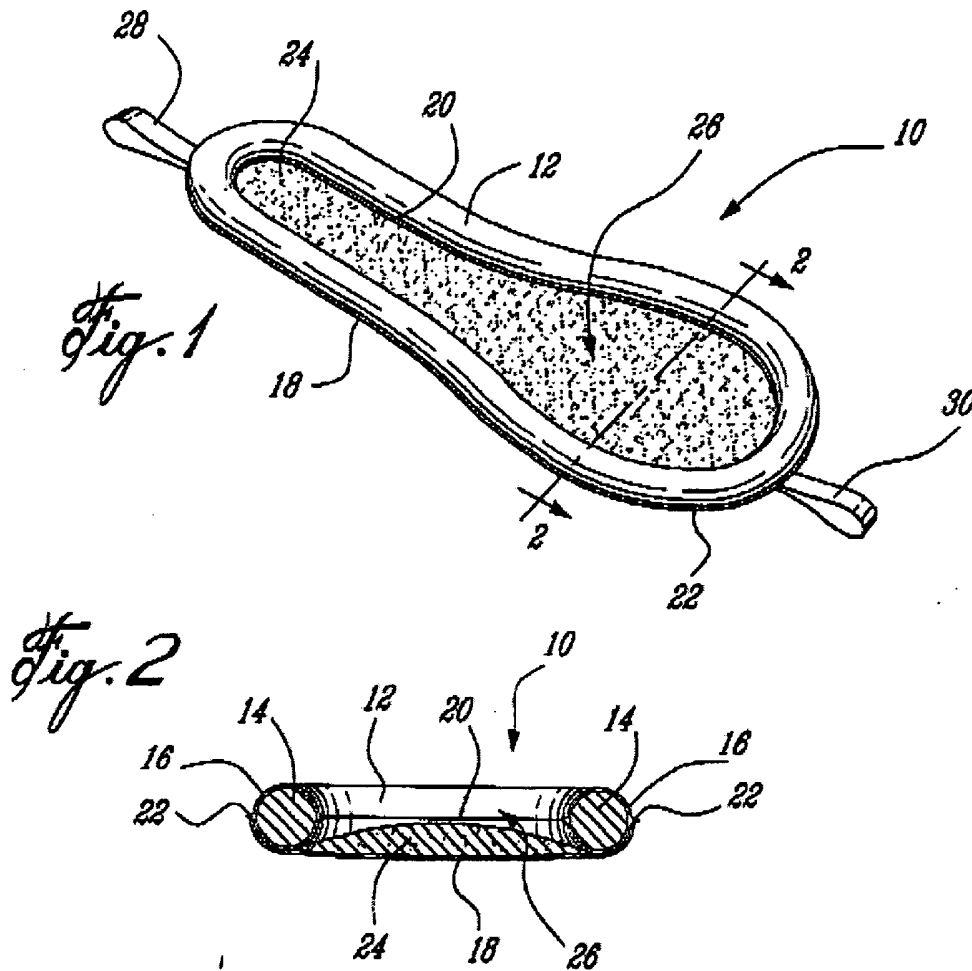
Art Unit: 3761

102 and 103, expressed as a 102/103 rejection. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. § 103 and for anticipation under 35 U.S.C. § 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. Therefore, a 35 U.S.C. § 102/103 rejection is appropriate for these types of claims as well as for composition claims.

"[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency under 35 U.S.C. § 102, on prima facie obviousness' under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, supra). MPEP § 2112.

Regarding claim 13, Rainville-Lonn teaches a third portion central crotch portion located between the longitudinal end portions.





***Claim Rejections – 35 USC § 103***

Claims 14 and 16-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rainville-Lonn as applied to claims 10-13 above, and further in view of Mason

Rainville-Lonn teaches a foam layer (14) over a highly absorbent layer (24), but does not expressly teach the use of a superabsorbent (§ 0019).

Mason teaches the use of superabsorbent to enhance absorbency (col. 6, lines 50-65).

Art Unit: 3761

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the superabsorbent layer of Mason in the resilient sanitary napkin of Rainville-Lonn in order to provide enhanced absorbency.

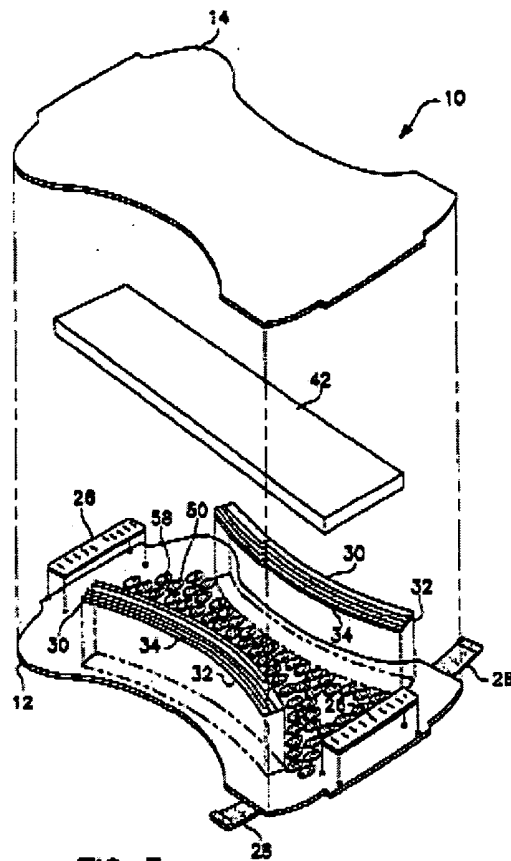
Regarding claims 14 and 16-21, the references do not teach the specific caliper of the article.

Mere changes in size are not sufficient to patentably distinguish an invention over the prior art. See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Claims 15 and 22-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rainville-Lonn and Mason as applied to claims 14 and 16-21 above, and further in view of Tanzer *et al.* (US 6,429,350 B1; hereinafter "Tanzer").

Rainville-Lonn and Mason do not expressly disclose an absorbent open-celled foam layer over a superabsorbent layer.

Tanzer teaches an absorbent containing open cell foam layer (42) over a superabsorbent layer (58). This construction eliminates the need for redundant layers of material, allowing the final absorbent article to have a thin caliper (col. 6, lines 14-53)(fig. 3).



**FIG. 3**

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the foam and superabsorbent layer construction of Tanzer in the sanitary napkin of Wada in order to provide a thin caliper.

### ***Response to Arguments***

Applicant's arguments with respect to claims 10-24 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 3761

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Bogart  
14 October 2006



JACQUELINE STEPHENS  
PRIMARY EXAMINER